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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/053,303	11/07/2001	KangYoon Lee	JP920000395	5802
<div>7590 01/26/2007 Robert P. Tassinari, Jr. Intellectual Property Law Dept. IBM Corporation P.O. Box 218 Yorktown Heights, NY 10598</div>			<div>EXAMINER ZECHER, MICHAEL R</div> <div>ART UNIT 3609 PAPER NUMBER</div>	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		01/26/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/053,303

Applicant(s)

LEE ET AL.

Examiner

Michael R. Zecher

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☒ Claim(s) 6, 13, 20 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

DETAILED ACTION

1. The following is a non-final, first office action on the merits. Claims 1-21 are pending.

Claim Objections

2. Claims 6, 13, and 20 are objected to because of the following informalities: grammatical error. The use of "the" before "each of the EBPP servers" is grammatically incorrect. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-7 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant fails to describe in claim 1 what "means for enabling" entails in such full, clear, concise, and exact terms that a skilled artisan would recognize the applicant was in possession of the claimed invention. Page 8, line 30 of the specification states "payment-related instructions may include transfer (or payment) method and payment (or transfer) date." The applicant fails to establish a strong correlation between structure and function, and without such correlation, the capability to recognize or understand the mere recitation of

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"means for enabling" from the minimal acts described on page 8, line 30 do not satisfy the written description requirement.

Claims 2-7 depend from claim 1, and are therefore also rejected for lack of adequate written description.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 1-4, 6-11, 13-18, and 20-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Dent et al. (U.S. 6,839,687).

As per claim 1, Dent et al. teaches a system for performing personal finance management using the internet, the system comprising:

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“means for obtaining a user’s bank account information data from the bank server” (See consumer interface unit, Figure 1, #28 (1-n), subsection cashflow analyzer, Figure 2, #54, which contain user’s bank account information);

“means for collection billing information data from each of the EBPP servers, said billing information data including an amount to be paid and payment due date” (See Figure 1, #24 & #26, which distributes billing statement via a service center over a network);

“means for presenting a payment-schedule based on said bank account information data and said billing information data” (See Figure 2, #48, subsections #52, #54, and #56, specifically #54, which asses how paying bills will impact the consumer’s cashflow);

“means for enabling the user to select how and when to pay the bills and forwarding said user’s selection on the payment to the bank server” (See bill payment process #56, which enables user to manage payment of electronic bills).

Claim 8 and 15 recite equivalent limitations to claim 1 and are therefore rejected using the same art and rationale as set forth above.

As per claim 2, Dent et. al. teaches that “user’s selection on the payment can be an immediate account transfer, a reserved account transfer, and automatic account transfer or transfer cancellation of the amount to be paid, from the user’s bank account” (See payment analyzer, Figure 2, #56, which allows selection of payment depending on the schedule chosen; specifically column 9 &

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10, steps 1-6 which discuss viable options if the payment schedule results in a negative balance).

Claims 9 and 16 recite the equivalent limitations in claim 2 and are therefore rejected using the same art and rationale as set forth above.

As per claim 3, Dent et al. teaches the “means for calculating and presenting an estimated account balance on the payment due date, in advance, assuming that said amount to be paid is transferred from the user’s bank account on the payment due date” (See cashflow analyzer in Figure 2, #54, and payment analyzer in Figure 2, #56, which calculate and estimate account balance).

Claims 10 and 17 recite the equivalent limitations in claim 3 and are therefore rejected using the same art and rationale as set forth above.

As per claim 4, Dent et al. teaches the “payment-schedule can be displayed on a daily basis, weekly basis, or monthly-basis” (See payment analyzer in Figure 2, #56, and column 3, lines 24-30, which coordinates different payment schedules for a bill payment cycle (e.g. a month)).

Claims 11 and 18 recite the equivalent limitations in claim 4 and are therefore rejected using the same art and rationale as set forth above.

As per claim 6, Dent et al. teaches the means for collecting billing information data comprising (See Figure 1 #22 and #24, and column 4, line 54, which portrays and discusses a biller computing unit):

“means for storing user identification information data for each of the EBPP servers” (See Figure 2 #48, and column 5, lines 57-67, bill management

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unit which portrays and discusses, respectively, bill handling and management functions, including receiving and storing electronic bill information);

“means for requesting billing information data to each of the EBPP servers using said stored user identification information” (See Figure 2 #48, and column 6, lines 34-43, which discusses the notification technique of launching the PFM application);

“means for storing the billing information received from each of the EBPP servers” (See Figure 2 #48, and column 5, lines 57-67, bill management unit which portrays and discusses, respectively, bill handling and management functions, including receiving and storing billing information).

Claims 13 and 20 recite equivalent limitations in claim 6 and are therefore rejected using the same art and rationale as set forth above.

As per claim 7, which includes the “means for alerting the user when said estimated account balance is less than zero” (See cashflow analyzer in Figure 2, #54, and payment analyzer in Figure 2, #56, which calculate and estimate account balance; specifically column 9 & 10, steps 1-6 which discuss how the cashflow analyzer optimizes a payment schedule if the result would be a negative balance).

Claims 14 and 21 recite the equivalent limitations in claim 7 and are therefore rejected using the same art and rationale as set forth above.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dent et al. (U.S. 6,839,687) in view of Hilt et al. (U.S. 6,032,133).

As per claim 5, Dent et al. teaches a system and method for performing personal finance management using the internet (See consumer interface unit, Figure 1, #28 (1-n), subsection cashflow analyzer, #24, #26, Figure 2, #48, subsections #52, #54, #56 which contain user's bank account information, distributes billing statements via a service center over a network, assesses how paying bills will impact the consumer's cashflow, and enables user to manage payment of electronic bills). However, Dent et al. does not expressly disclose a "means for presenting the payment result received from the bank server to the user."

Hilt et al. discloses a "means for presenting the payment result received from the bank server to the user" via a confirmation receipt (See Figure 2, #66 which discloses a confirmation receipt sent to the consumer following the payment of a bill).

Both Dent et al. and Hilt et al. disclose a method and system that seek to use an electronic bill pay system. Hilt et al. expressly discloses a means for notifying the user of a payment result via a confirmation receipt. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include a means of notifying the user of an electronic bill pay method

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or system that the payment result was confirmed. (See Hilt, Figure 2, #66 and column 6, line 50, which portray and discuss the material passing among participants of an electronic bill pay system).

Claims 12 and 19 recite equivalent limitations in claim 5 and are therefore rejected using the same art and rationale as set forth above.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Schutzer (U.S. 6,292,789) discloses a method and system for bill presentment and payment.

Kolling et al. (U.S. 5,920,847) discloses an electronic bill pay system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael R. Zecher whose telephone number is N/A. The examiner can normally be reached on M-F 7:30-5:00 alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynda Jasmin can be reached on 571-272-6782. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MZ

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